



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,063	11/24/2003	David W. Nelson	36729-198472	9139
26694	7590	03/21/2007	EXAMINER	
VENABLE LLP			ROWAN, KURT C	
P.O. BOX 34385				
WASHINGTON, DC 20043-9998				
			ART UNIT	PAPER NUMBER
			3643	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
2 MONTHS		03/21/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**MAILED**

MAR 21 2007

**GROUP 3600**

---

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/719,063  
Filing Date: November 24, 2003  
Appellant(s): NELSON, DAVID W.

---

David Nelson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 4, 2006 appealing from the Office  
action mailed March 23, 2005

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2002-2275

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Art Unit: 3643

EP 0 367 539

SHERMAN

5/1990

4052811

SHUSTER

10/1977

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 9, 11, 12, 18 are rejected under 35 USC 102(b) as being anticipated by Hughes.

---

Claims 1-3, 12 are rejected under 35 USC 102(b) as being anticipated by "Post-It" notes.

Claims 2-3, 5-6, 7-8, 10, 17 are rejected under 35 USC 103(a) as being obvious over Hughes.

Claims 13, 14, 15, 16 are rejected under 35 USC 103(a) as being obvious over Hughes in view of Sherman (EP 0 367 539).

Claims 19-20 are rejected under 35 USC 103(a) as being obvious over Hughes in view of Sherman and further in view of Shuster.

### **(10) Response to Argument**

Applicant argues that Hughes does not embed the pest within the substrate and that merely encapsulates or surrounds the rodent or insect. However, since Hughes surrounds the pest such as shown in Fig. 4, if the substrate were a bag, the pest would be in the bag which is the same as being embedded within the bag. Since Hughes can be considered to embed the pest within the substrate. As to the substrate of Hughes being compressible, it is inherent that the substrate of Hughes is compressible since all solid materials can be compressed to some extent. As a material is compressed, it is

Art Unit: 3643

collapsing. Applicant further argues that the Post-It note is made from paper that is already highly compressed, but it should be noted that by putting a clamp on a pad of Post-It notes that the pad can be compressed. If the pad is being compressed then so are all the sheets in the pad. As to the statement that masking tape is structurally similar to "Post-It" notes, there appears to be a fundamental difference between the two which is that masking tape has no paper substrate like the "Post-It" notes. Hughes

shows a substrate of adhesive covered material as disclosed in column 2, line 1.

Hughes does not disclose what the substrate is made from but as clearly shown in Fig. 4, there is a substrate under the adhesive. Hence Hughes accurately defines a substrate as claimed. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. Applicant argues that this combination would be less effective at trapping or capturing pest, but has submitted no evidence that this is the case. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800

Art Unit: 3643

F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Sherman discloses a substrate coated with a viscous insecticidal substance that inhibits movement from the plate in a horizontal or vertical manner. In this respect, the material of Sherman can be considered as an adhesive since it sticks to the plate or substrate. It should be pointed out that applicant's arguments with respect to oil not being an adhesive are not quite correct since not only do particles become suspended in oil which means that the oil adheres to the particles,

but also, two sheets of paper with oil rubbed between can adhere to each other and thus oil has some adhesive properties. Sherman further discloses an adhesive 122 and self-adhesive strip 124. In reference to claim 17, applicant's arguments with respect to Hughes and the problem of leakage of body fluids, but one skilled in the art would employ a material that would have increased absorptive powers like one around the house employing paper towels to take care of a spill. The examiner is not trying to combine a conventional paper towel with the references of record, but merely showing the skill level of an ordinary pest controller. Further see the patent to Shuster (cited above) for the problem and a solution to insects leaking fluids from body parts. Hence the problem of leaking body parts was appreciated by those skilled in the art. It should be pointed out that applicant's claims do not preclude the use of poison since the open-ended term "comprising" was used.

#### **(11) Related Proceeding(s) Appendix**

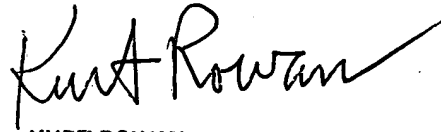
Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

Art Unit: 3643

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kurt Rowan



KURT ROWAN  
PRIMARY EXAMINER  
GROUP 3200

Conferees:

Jeff Gellner



David Parsley

